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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/293,266	04/16/1999	RAYMOND WALDEN BENNETT III	A00513	4651

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EXAMINER

AGDEPPA, HECTOR A

ART UNIT	PAPER NUMBER
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2642

34

DATE MAILED: 05/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/293,266

Applicant(s)

BENNETT III ET AL.

Examiner

Hector A. Agdeppa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to applicant's response filed on 3/1/04. Claims 1 - 19 are now pending in the present application. **This action is made final.**

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1 – 4, 6, 8 – 11, 13 – 17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brandon in view of Mirville et al.

As to claims 1 – 4, 6, 8 – 11, 13 – 17, and 19, Brandon teaches an automated telephone directory for creating outgoing call logs wherefrom called numbers and/or the

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names associated with the called numbers may be displayed display 3 of telephone 1, retrieved, and dialed by a single input made by depressing call key 82. (Abstract, Figs. 1, 4 – 7, Col. 2, lines 32 – 67, Col. 3, line 54 – Col. 4, line 34, and Col. 5, line 7 – Col. 6, line 64)

However, it is able old and well known that service residing in/on a telephone unit may be provided at a central office (C.O.) or switch, the functionality no longer residing with the telephone, but within the C.O. or switch requiring a caller to dial a service code to invoke a feature and presenting any information via audio messaging. Examples of this are voice mail (as opposed to an answering machine) and remote access speed dialing (as opposed to local speed dialing, i.e., database kept in switch as opposed to being kept in telephone unit) such as the system for on-demand communications services taught by Mirville et al.

Mirville et al. teach a caller using telephone or end unit 101, 103, 105 to dial a service code such as #1 to access the speed dial feature and wherein the list of speed dial numbers resides in a storage device 190 separate from units 101, 103, or 105. (Figs. 1, 3, 4, Col. 6, lines 28 – 54)

It would have been obvious to one skilled in the art to implement the invention of Brandon in the manner taught by Mirville et al., i.e. functionality residing away from the telephone, making it thus necessary to dial a service code and receive relevant information via audio messaging inasmuch as it is old and well known to implement telephony features in either environment. Furthermore, keeping an outgoing call log in a C.O. or switch allows for more memory and therefore a more extensive outgoing call

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log may be kept. Also, situations arise if outgoing call logs kept only on telephone unit wherein if a caller has multiple telephones, that caller must use the same telephone previously used in order to redial a previously called number, because there is no way for that previously dialed number to be transferred to another telephone. Also, because, often, listening to audio messages, in particular, those reciting lists are difficult to remember and use information contained therein, visually displaying lists is favored. However, many telephones commonly used today still do not display information and thus, lists would have to be presented via audio messaging. Furthermore, such is simply an issue of preference or design choice as to whether an outgoing call list is to be presented visually or via audio messaging. Also, to that point, a blind caller would have to have information normally visually displayed, converted to audio or Braille, in either case, requiring converting data into a preferred format and such conversions are old and well known in the art, again making the modification of Brandon's invention from a visual apparatus to an audio apparatus obvious to one skilled in the art.

3. Claims 5, 7, 12, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brandon in view of Mirville et al. and further in view of Levine.

As to claims 5, 12, and 18, Brandon and Mirville et al. have been discussed above. What they do not teach is the use of a vertical service code.

However, any type of service code used to access a service or feature is a question of preference or design choice making the use of a vertical service code obvious to one skilled in the art. Furthermore, as taught by Levine, vertical service

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codes are old and well known in the art and it would again be obvious to access redial features of the claimed invention using such. (Col. 12, lines 1 – 46 of Levine)

As to claim 7, Brandon teaches displaying outgoing call lists one page at a time. If this were translated into audio, it is obvious if not inherent that call lists would be presented in blocks likened to pages, perhaps 4 numbers at a time to make it easier for a user to utilize redial feature or at least present numbers one at a time, requiring a user to somehow prompt a next number to be presented. Therefore, the page scrolling taught by Brandon would be translated into the first and second audio messages and multiple dial inputs of the claimed invention. Also, as discussed above, as in the case of voice mail or many other services provided remotely to a user, a PIN would be necessary and thus it is obvious if not inherent to require the inputting of a PIN as claimed by the instant invention.

Response to Arguments

4. Applicant's arguments filed 3/1/04 have been fully considered but they are not persuasive.

Applicant's arguments do not cite any deficiencies in the functionality or operation of either Brandon or Mirville et al. that would make them substantively different from the claimed invention. Rather, applicant's arguments focus only the obviousness, or alleged lack thereof, of taking a self-contained telephone with directory features and implementing such functionality in the actual telephone network. Examiner maintains his previous rejection as well as his motivation (see above in the rejection).

Therefore, the only issue is that of motivation. As already mentioned above, there is ample motivation for moving functionality from the telephone network to a stand-alone device and vice versa. One motivation for moving functionality to the telephone network is that features like voice mail (essentially the functionality of an answering machine disposed on the telephone network) and speed dial may be offered to all customers without the use of dedicated telephones. Note that speed dial is another feature that can be implemented in a stand-alone telephone with its own memory and directory, or may be implemented in the telephone network such as taught by Mirville et al. Another motivation is that many customer only want certain features on a pay-per-use basis because it is not economically feasible or desirable for them and this is effected by implementing those features on the telephone network. Such is also taught by Mirville et al.

Also, applicant asserts that Branon teaches away from implementing a directory feature on the telephone network. However, Mirville et al. provides motivation and examples of directories (such as speed dial and frequently called number directories) that reside on the telephone network. All of the necessary components mentioned by applicant on page 3, the second paragraph, are all common components that would easily be implemented in a telephone network, such as a central processing unit and databases. Clearly, the telephone network provides for central processing unit, i.e., a function/directory processor that controls that feature for all subscribers, and databases (as seen in Mirville et al.) are implementable in a telephone network.

In short, nothing in Brandon actually teaches away from being implemented in a telephone network. Nothing in its operation would be affected by moving the functionality to the telephone network except the fact that it would be accessible through the network instead of a stand-alone, dedicated unit. The principle of Brandon's invention is to provide an automated telephone directory with certain features, as discussed above. Merely because one designer or telephone service provider chooses to leave such functionality to a stand-alone device as opposed to implementing it in the telephone network is, as argued by examiner, obvious.

Moreover, even if arguendo, Brandon initial motivation was to implement a feature in a stand-alone device, as discussed above and as taught by Mirville et al., it is extremely common for a telephone provider to begin offering popular features, originally invented as stand-alone devices, on the telephone network, again, such as voice mail and speed dial. Therefore, the obviousness examiner is asserting is not foreclosed merely because one reference (Brandon) teaches an implementation in a stand-alone device. Such is the reason for Mirville et al. as a secondary reference, not to mention motivation, generally known, and provided by Mirville et al. is also present. Brandon may not have envisioned his functionality on the telephone network, but certainly, Mirville et al. and those skilled in the art would.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hector A. Agdeppa whose telephone number is 703-305-1844. The examiner can normally be reached on Mon thru Fri 9:30am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad F. Matar can be reached on 703-305-4731. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

H.A.A.
May 14, 2004


AHMAD F. MATAR
SUPERVISORY PATENT EXAMINER
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